

JAN 22 2007

SMART & BIGGAR

Intellectual Property & Technology Law

To Fax no.: (571) 273-8300 438 University Avenue
Page 1 of: 8 Suite 1500, Box 111
Attention: Commissioner for Patents Toronto, Canada M5G 2K8
Attn: Joseph E. AVELLINO, Examiner Tel.: (416) 593-5514
From: Matthew Zischka Fax: (416) 591-1690
Your file no.: Patent S.N. 09/825,412; Art Unit: 2143 Date: January 22, 2007
Reply to Toronto file no.: 92027-5 Time:

Transmitted herewith are:

(✓) Transmittal Form PTO/SB/21

(✓) Appellant's Reply Brief Under 37 C.F.R. 1.193(b)

RE: APPLICATION

APPLICANT: Grant HOOD et al.
SERIAL NO.: 09/825,412
FILED ON: April 3, 2001
OUR FILE: 92027-5
DUE: January 22, 2007
TITLE: METHODS AND DEVICES FOR PROVIDING POOLED PERSONAL
INTRODUCTION SERVICES

If there are any transmission problems, please call (416) 593-5514.

Original copy and any enclosures

☐ will be sent by ☐ mail
☒ will not ☐ courier

The information contained in this transmission is confidential and only for the intended recipient identified above. If you are not the intended recipient, you are hereby notified that any dissemination or use of this communication is unlawful. If you have received this transmission in error, please immediately notify us by telephone (collect). Return the original message to us and retain no copy.

JAN 22 2007

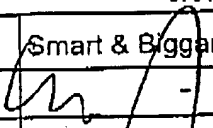
PTO/SB/21 (09-08)

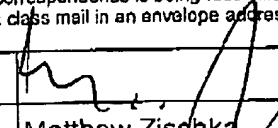
Approved for use through 03/31/2007. CMB 0651-0031

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/825,412
	Filing Date	April 3, 2001
	First Named Inventor	Grant HOOD
	Art Unit	2143
	Examiner Name	Joseph E. AVELLINO
Total Number of Pages In This Submission	Attorney Docket Number	92027-5

ENCLOSURES (Check all that apply)		
<input type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation <input type="checkbox"/> Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input type="checkbox"/> Other Enclosure(s) (please identify below):
Remarks		
SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Smart & Bigger	
Signature		
Printed name	Matthew Zischka	
Date	January 22, 2007	Reg. No. 41,575

CERTIFICATE OF TRANSMISSION/MAILING	
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:	
Signature	
Typed or printed name	Matthew Zischka
Date	January 22, 2007

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

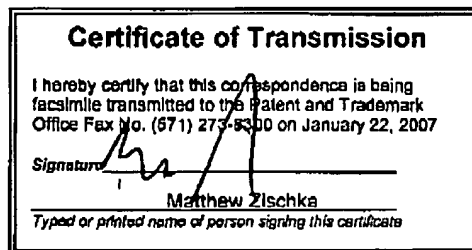
If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

JAN 22 2007

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE HONORABLE BOARD OF PATENT APPEALS

In re the application of:)
Grant HOOD et al.)
Application No:09/825,412)
Filed: April 3, 2001)
For: Methods and Devices)
For Providing Pooled)
Personal Introduction)
Services)

Group Art Unit: 2143
Examiner: Joseph E. AVELLINO
Attorney Docket: 92027-5



APPELLANT'S REPLY BRIEF UNDER 37 C.F.R. 1.193(b)

The Assistant Commissioner of Patents
Washington, D.C. 22313
U.S.A.

Dear Sir or Madam:

The following is the Appellant's Reply Brief, submitted under the provisions of 37 C.F.R. 1.193.

This Reply Brief is responsive to the Examiner's Answer, mailed December 21, 2006 (hereinafter "Examiner's Answer"). However, in this Reply Brief the Applicant does not intend to address all of the claims pending in the application nor all of the issues raised by the Examiner in the Examiner's Answer. The Applicant reasserts all submissions made in the Appeal Brief. Submissions presented in this Reply Brief are presented to address the Examiner's Response to Argument further clarify the Applicant's position and are in no way intended to detract from arguments previously made by the Applicant.

Group Art Unit: 2143

JAN 22 2007

As previously set out in the Appellant's Appeal Brief, the Examiner has rejected independent claims 1 to 14 and 16 to 20 under 35 U.S.C. 103(a) in view of US Patent Publication 2002/0073343 to "Ziskind" et al. (hereinafter "Ziskind") and US Patent No. 6,665,3879 to "Haste" (hereinafter "Haste").

Claims 1-20 claim systems and methods of facilitating exchange of messages at a computerized message exchange system (e.g. computerized dating systems). A first and second plurality of greetings are stored at the system. Each of the first plurality of greetings associated with users of a first introduction service provider. Each of the second plurality of greetings associated with a user of an introduction service provider, different from the first introduction service provider. Users associated with the first introduction service provider are allowed access to selected ones of the second plurality of greetings, based on criteria associated with an originator of each of the selected ones of the second greetings and criteria set by the first introduction service provider.

Users associated with the first introduction service provider may thus have access to greetings of users associated with other service providers, effectively increasing the number of persons to whom the users associated with the first introduction service provider may be introduced. Conveniently, access to greetings of various service providers and various users may be filtered, so that users of the first service provider only have access to users of selected other service providers, and to users having sanctioned interests.

The primary reference applied by the Examiner, Ziskind, has little to do with the present invention. It is directed to a system allowing exchange of Instant Internet messages. Instant messaging serves a fundamentally different purpose than introduction services, the subject of the present application. Instant messaging is designed to allow individuals, regardless of their specific interest, to communicate with each other. Thus, allowing users of one instant messaging service access to users of another is consistent with the underlying purpose of instant messaging, and is in principal no different

than allowing subscribers of different phone companies to communicate with each other. As detailed in the background of the present application, introduction services are designed to introduce specific persons sharing a common interest, for, for example, social or dating purposes. As such, introduction service providers typically operate closed systems that only allow limited access between subscribers. A person of ordinary skill would thus have no motivation to use instant messaging systems and modify them to arrive at an introduction service, as suggested by the Examiner.

More fundamentally, however, even if Ziskind and the remaining references were combined, a person of ordinary skill would not arrive at the claimed invention, as neither Ziskind nor the remaining references disclose all elements of independent claims 1, 12 or 17.

As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second greetings; and criteria set by the first service provider. In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service provider include the gender, age and interest of users of the second service provider.

Group Art Unit: 2143

In response to this argument, the Examiner's continues to misread the claims and Ziskind. The Examiner asserts at page 10 in his Examiner's Answer

"As to point (2), the Examiner agrees with the recitation of cited passages by the Appellant, however, disagrees that the combination does not disclose figin access to selected users by the first service provider. As evidenced by the cited passges by the Appellant (specifically p.3 ¶ 32 of Ziskind) a user directory allowing the user the ability to determine whether or not the user should be visible by others (i.e. notify others that user X has signed on). This way, user Y cannot view user X's information without the permission of X. In this fashion, the system gives access to user Y only those users which request to be displayed in the user directory. Utilizing the greetings of the internet dating system of Haste, results in multiple affiliated dating and introduction services pooling together resources in order to get a wide variety of messengers to communicate with one another."

To illustrate the deficiency in this reasoning, the following attempts to map the FIRST USER/SECOND USER language of the claims to the Examiner's reasoning:

As evidenced by the cited passges by the Appellant (specifically p.3 ¶ 32 of Ziskind) a user directory allowing the user [SECOND USER] the ability to determine whether or not the user [SECOND USER] should be visible by others (i.e. notify others that user X [SECOND USER] has signed on). This way, user Y [FIRST USER] cannot view user X's [SECOND USER] information without the permission of X [SECOND USER].

This reasoning, however, is not consistent with the claim language. As claimed in claim 1,

"users associated with said first introduction service provider, access to selected ones of said second plurality of greetings, based on criteria associated with an originator of each of said selected ones of said second greetings, and criteria set by said first introduction service provider."

That is, users of a first introduction service provider are given access to greetings of selected users of a second service provider. The selection is based on criteria associated with the originators of each of the second

Group Art Unit: 2143

greetings, and criteria set by the first service provider, and not the second user (i.e. not "the permission of X, argued by the Examiner"). Not surprisingly, in the instant Internet messaging system of Ziskind, it is user X that decides whether or not he/she should be viewable by user Y. As claimed, it is the second user [user X] and the first user's service provider [the service provider for user Y] that set criteria used to decide.

In this way, the effective number of users whose greetings are apparently available to users of the first service provider is increased, by pooling greetings of users of the first and second service providers. At the same time sensitivities of the users of the first service provider, and the service provider itself are respected, by selecting which greetings of which users of the second service provider access are provided based on the originator of each of the second greetings, and criteria set by the first service provider. Example criteria used by the first service provider include the gender, age and interest of users of the second service provider.

To establish a *prima facie* case of obviousness under 35 USC 103., all claim elements must first be found in the art, and there must be a motivation to combine/modify to arrive at the invention. All claim elements have not been found in the art. The mere presence of a subset of the elements in the art, and knowledge of the applicants' invention is simply insufficient to conclude that a person of ordinary skill would arrive at the remaining claim elements and the invention. As such, the conclusion reached by Examiner does not appear to be based on the cited art but instead appears to be made with impermissible hindsight.

For all of these reasons, and those contained in the Appellant's Brief, it is submitted that the Examiner has failed to establish a *prima facie* case of obviousness. Reversal of the Examiner's rejections under 35 USC 103 is therefore respectfully requested.

Jan-22-07

04:13pm From-

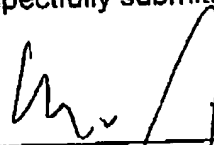
Serial NO.: 09/020,712

Group Art Unit: 2143

T-391 P.008/008 F-500

Respectfully submitted,

By



Matthew Zischka
Registration No.: 41,575

SMART & BIGGAR
438 University Avenue
Suite 1500, Box 111
Toronto, ON
Canada
M5G 2K8

Telephone: (416) 593-5514
Facsimile: (416) 591-1690

January 22, 2007
(92027-5)
MZ/kdr
Enclosure
